

REMARKS

I. Introduction

With the cancellation herein without prejudice of claims 18, 24, 32, 34 and 35, claims 17, 19 to 23, 25 to 31 and 33 are currently pending in this application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication of receipt of copies of the certified copy of the priority document from the International Bureau.

II. Rejection of Claims 17 to 19, 22 to 31, 33 and 35 Under 35 U.S.C. § 112

Claims 17 to 19, 22 to 31, 33 and 35 were rejected under 35 U.S.C. § 112, first paragraph as allegedly not enabling a person skilled in the art to make and use the invention commensurate in scope with the claims. Claims 18, 24, 32, 34, 35 have been canceled herein without prejudice or waiver, thereby rendering moot the rejection of these claims. Applicants submit that claims 17, 19, 22, 23, 25 to 31 and 33 are allowable for the following reasons.

The Office Action alleges that the Specification, while being enabling for treating the substrate with a siloxane, does not reasonably provide enablement for any material being used to treat the substrate. See Final Office Action at p. 2. Applicants respectfully disagree for the following reasons.

M.P.E.P. § 2164 states that when the subject matter is not in the Specification portion of the application as filed but is in the claims, the limitation in and of itself may enable one skilled in the art to make and use the claim containing the limitation.

M.P.E.P. § 2164.01 states that the standard for determining whether the Specification meets the enablement

requirement was cast in the Supreme Court decision of Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? Accordingly, the test for enablement is whether a person skilled in the art could practice the claimed invention without undue experimentation. M.P.E.P. § 2164.01 (a) requires that the Examiner consider all of the following factors in determining whether any experimentation is "undue":

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

M.P.E.P. § 2164.01 (a) states that it is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The Examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole.

Applicants submit that the Office Action has not presented a prima facie case of lack of enablement as no consideration has been presented as to all of the above requisite factors, as required by M.P.E.P. § 2164.01 (a). Accordingly, withdrawal of this rejection is respectfully requested. Applicants further submit that the Specification and the limitations of claims 17, 19, 22, 23, and 25 to 31, in and of themselves, as per M.P.E.P. § 2164, enable one skilled in the art to make and use the invention as claimed in claims

17, 19, 22, 23, and 25 to 31. Amended independent claim 17, upon which claims 19, 22 and 25 to 31 ultimately depend, recites the step of esterifying the ceramic surface areas. Further, the Final Office Action admits that the Specification discloses esterifying the ceramic surface areas with siloxane. See Final Office Action at p. 2 and the Specification at p.4, line 23. Furthermore, Applicants direct the Examiner's attention to original claim 1, which recites "[a] method for treating the surface of a ceramic hybrid substrate having ceramic surface areas and metallic surface areas, . . . wherein the ceramic surface areas . . . are esterified," and to original claim 16, which recites "[a] ceramic hybrid substrate with a surface having ceramic surface areas and metallic surface areas, . . . wherein the ceramic surface areas . . . are esterified." Applicants respectfully submit that one skilled in the art would not have to unduly experiment to achieve the step of esterifying the ceramic surface areas in light of the disclosure in the Specification of the use of siloxane to esterify the ceramic surface and the original claims..

Therefore, Applicants submit that 17, 19, 22, 23, and 25 to 31 are enabling. Accordingly, withdrawal of the 35 U.S.C. § 112 rejection and allowance of claims 17, 19, 22, 23, and 25 to 31 is respectfully requested.

III. Rejection of Claims 17 to 31 and 33 to 35 Under 35 U.S.C. § 112

Claims 17 to 31 and 33 to 35 were rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Final Office Action alleges that the recitation in claims 17, 34 and 35 that only the ceramic surface area is esterified is not disclosed in the Specification. Final Office Action at p. 3. Claims 18, 24,

34 and 35 have been canceled herein without prejudice or waiver, thereby rendering moot the rejection of these claims. Applicants submit that claims 17, 19 to 23, 25 to 31 and 33 are allowable for the following reasons.

As an initial matter, the Office bears the initial burden of presenting "evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added). The Manual of Patent Examining Procedure also provides that if an examiner rejects a claim based on the lack of a written description, the examiner should "identify the claim limitation not described" and provide "reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application." (See id.). However, the written description requirement is not an in haec verba requirement. That is, "the specification need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed.'" All Dental Prodx LLC v. Advantage Dental Products Inc., 64 U.S.P.Q.2d 1945, 1948 (Fed. Cir. 2002) (quoting Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 U.S.P.Q.2d 1467, 1470 (Fed. Cir. 1995)). Moreover, a "failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented." All Dental Prodx, 64 U.S.P.Q.2d at 1948 (citing Eiselstein, 52 F.3d at 1039, 34 U.S.P.Q.2d at 1470). An applicant can show "possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention." M.P.E.P. § 2163 (citing

Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997)).

Since the Final Office Action states that "[t]he examiner cannot find where the term 'only' appears in the Specification," it is respectfully submitted that the present rejection appears to be reflect an improper in haec verba requirement and should be withdrawn for this reason alone. Moreover, the Specification makes clear to one skilled in the art that only the ceramic surface areas are esterified. For example, the Specification states that as a result of the esterification, a monomolecular surface layer is formed on the ceramic surface areas which is resistant to chemicals and heat, so that metal coatings chemically deposited on the metallic surface areas are not able to deposit on the ceramic surface areas. See the Specification at p. 2, lines 24 to 28. Respectfully, if the esterification prevents metal coatings from depositing on the ceramic surface areas then if the metallic surface areas were esterified such esterification would also prevent metal coatings from depositing on the metallic surface areas. However, the Specification specifically states that metal coatings are chemically deposited on the metallic surface areas. See the Specification at p. 2, lines 26 to 27. Therefore, it is respectfully submitted that the Specification makes clear to one skilled in the art that the metallic surface areas are not esterified, i.e., that only the ceramic surface areas are esterified.

Further, Applicants submit that the disclosure in the Specification regarding coating the ceramic hybrid substrate with a coating solution and subsequently removing the coating solution from just the metallic surface areas (Specification at p. 3, lines 9 to 14) makes clear to one skilled in the art that Applicants were in possession of a method for treating the surface of a ceramic hybrid substrate, including both ceramic surface areas and metallic surface areas, comprising the step of esterifying only the ceramic surface areas, as recited in claim 17. The Specification

specifically states that the metallic surface areas 16 do not react with the organic components, so that they are unchanged after residual quantities 18" have been detached chemically and mechanically. See the Specification at p. 5, lines 14 to 17.

In view of the foregoing, it is respectfully submitted that claims 17, 19 to 23, 25 to 31 and 33 fully comply with the requirements of 35 U.S.C. § 112, and withdrawal of this rejection is therefore respectfully requested.

**IV. Rejection of Claims 17 to 20, 22, 23, .
27, 34 and 35 Under 35 U.S.C. § 102(b)**

Claims 17 to 20, 22, 23, 27, 34 and 35 were rejected under 35 U.S.C. § 102(b) as anticipated by White, Proceedings of the IEEE, 57(9), pp. 1610 to 1615, 1969 ("White").

While Applicants respectfully disagree with the merits of this rejection, to facilitate matters, claims 18, 34 and 35 have been canceled herein without prejudice or waiver, thereby rendering moot the rejection of these claims. Further, claim 17 has been amended to incorporate the limitations of claim 24, which was indicated to include allowable subject matter, and its dependent claim 18. It is therefore respectfully submitted that claim 17 is in condition for immediate allowance. Claims 19, 20, 22, 23 and 27 ultimately depend from claim 17 and therefore include all of the limitations of claim 17. Accordingly, Applicants respectfully submit that claims 19, 20, 22, 23 and 27 are also in condition for immediate allowance.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**V. Rejection of Claims 21, 28
and 29 Under 35 U.S.C. § 103(a)**

Claims 21, 28 and 29 were rejected under 35 U.S.C. § 103(a) as unpatentable over White.

As indicated above, claim 17 has been amended to incorporate the limitations of claim 18 and claim 24, which was indicated to include allowable subject matter. Claims 21, 28 and 29 ultimately depend from claim 17 and therefore include all of the limitations of claim 17. Accordingly, Applicants respectfully submit that claims 21, 28 and 29 are allowable for at least the reasons that claim 24 was indicated to include allowable subject matter. Withdrawal of this rejection is respectfully requested.

VI. Allowable Subject Matter

Applicants note with appreciation the indication of allowable subject matter contained in claims 24 to 26, 30, 31, and 33. In this regard, the Examiner will note that claim 17 has been rewritten to include the limitations of claims 18 and 24 and that claims 18 and 24 have been canceled without prejudice or waiver. It is therefore respectfully submitted that claims 17, and claims 19 to 23 and 25 to 29, which ultimately depend from claim 17, are in condition for immediate allowance.

The Examiner will further note that claims 30 and 33 have been rewritten herein in independent form and are therefore believed to be in condition for immediate allowance. Claim 31 depends from claim 30 and is therefore also believed to be in condition for immediate allowance.

VII. Priority

As regards the statement that "Applicant should include a reference to the PCT priority at the beginning of the specification," Final Office Action at page 6, the Examiner's attention is directed to M.P.E.P. § 1893.03(c), which states that "since the international application is not an earlier application . . . , a benefit claim in the national stage to the international application is inappropriate" and that "it is not necessary for the applicant to amend the first sentence of the specification to reference the international application number."

VIII. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated:

January 5, 2001

By:

Richard L. Mayer
Reg. No. 22,490
B, No. 42,194

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646